



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/706,513	11/03/2000	John J. Gabrick	MINMAT.P03	6517

47022 7590 03/24/2006

THE LAW OFFICE OF RICHARD W. JAMES
25 CHURCHILL ROAD
CHURCHILL, PA 15235

EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT PAPER NUMBER

3624

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

DETAILED ACTION

1. This office action is in response to applicants' communication filed on December 23, 2005. The examiner would like to point out that the current examiner of record is Dr. Narayanswamy Subramanian (Art Unit 3624). Applicants are respectfully advised to address all future correspondences pertaining to the instant application to the examiner of record. Amendments to claims 1 and 3-8 have been entered. Rejection of claim 7 made under 35 USC § 112, second paragraph in the last office action is withdrawn in view of the amendments. Claims 1 and 3-8 are currently pending and have been examined. The rejections and response to arguments are stated below.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 1 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Germeraad et al (Reference U) in view of Cho et al (US Patent 6,539,403 B2).

With reference to claim 1, Germeraad teaches a system comprising at least one computer with at least one database of company innovation data resident thereon; wherein the system automatically summarizes company innovations (See Germeraad Page 36 Column 2), and generates reports which list potential competitive strengths or weaknesses of the innovations (See Germeraad Page 36 Column 2 and Page 37 Column 1). The invention reports, stage-gate

Art Unit: 3624

review inputs and evaluation attributes are interpreted to include potential competitive strengths or weaknesses of the innovations.

Germeraad does not explicitly teach the step of using intelligent agents to automatically perform searches on the Internet to find competing ideas.

Cho teaches the step of using intelligent agents to automatically perform searches on the Internet to find competing ideas (See Cho abstract and Column 7 lines 21-34). The spreadsheet program of Cho is interpreted to include intelligent agents.

Both Germeraad and Cho are concerned with the problem of managing information. It would have been obvious to one with ordinary skill in the art at the time of the current invention to combine the teachings of Cho to the invention of Germeraad. The combination of the disclosures taken as a whole, suggests that users would have benefited from the quick and timely retrieval of information over the Internet (See Cho Column 3 lines 36-40).

4. Claims 3-8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Germeraad et al (Reference U) in view of Cho et al (US Patent 6,539,403 B2) and further in view of Ghiraldi (Reference V).

Claim 3, Germeraad teaches a system of claim 1 as discussed above including the step comprising a query engine to determine and report any ideas that an individual has submitted over a selected time period (See Germeraad Page 38). Tracking ideas from their inception to their outcome includes this feature.

Germeraad does not explicitly teach the step wherein said company innovation data includes at least one idea submitted by an employee and a time at which the idea was submitted.

Ghiraldi discloses the step wherein said company innovation data includes at least one idea submitted by an employee (See Ghiraldi Page 100, first column first paragraph and page 102 first column third paragraph) and a time at which the idea was submitted (See Ghiraldi Page 102, second column second paragraph).

Both Germeraad and Ghiraldi are concerned with aggregation and dissemination of knowledge assets. It would have been obvious to one with ordinary skill in the art at the time of the current invention to combine the teachings of Ghiraldi to the invention of Germeraad. The combination of the disclosures taken as a whole, suggests that employees working among far flung offices to collaborate and share ideas and innovations.

Claims 4 and 5, the steps of measuring employee and corporate innovation levels (inherent in Germeraad's disclosure), the hours spent by on the innovation by the employee, documenting resources that contributed to the innovation (See Germeraad page 38) are old and well known. These steps help the management reward outstanding employees for their contribution and excellence. Germeraad discloses the steps of overall corporate innovation levels (inherent in Germeraad's disclosure), documenting resources that contributed to the innovation (See Germeraad page 38), so that IP assets can be assigned tangible values and tracked (See Germeraad Page 39).

Claim 6, Germeraad teaches a system for streamlining at least one of creating, preserving and protecting proprietary assets, the system comprising at least one computer with at least one database of company innovation data resident thereon, wherein the system performs at least one of identifying, classifying, compiling, tracking and routing, real-time innovation data automatically on a continuous basis (See Germeraad Page 36 Column 2 - Page 38 Column 2),

and provides access to the database of innovation information (See Germeraad Page 36 Column 2 - Page 37 Column 1), taken from the group of innovation information consisting of trade secret archives, patent filings, computed valuations, and user information (See Germeraad Page 41 Column 2), further wherein an employee thereby has access to innovation data submitted to the system by the employee (See Germeraad Page 36 Column 2 - Page 38 Column 2 and the disclosure of Ghiraldi).

Claim 7, Germeraad teaches the step of an employee entering an intellectual creation taken from the group of intellectual creations consisting of documents, idea and schematics (See Germeraad Page 36 Column 2 - Page 38 Column 2), and receiving a time/date certification therefor (Electronic time/date certification for submissions is old and well known. This provides proof of submission and the time submitted to the user and also facilitates an audit trail).

Claim 8, Ghiraldi teaches the step of a user links more details related to the intellectual creation, and other users emailing at least one of comments and suggestions directly to the employee, and submitting their own improvements on the intellectual creation (Inherent in Ghiraldi's disclosure).

Response to Arguments

5. In response to applicant's argument that Germeraad does not disclose summarizing company innovations, the examiner respectfully disagrees. For instance in Table 1 on Page 3 of Germeraad the Intellectual Asset tool has several components like the invention disclosure database, IP attributes etc, which summarize company innovations. Hence Germeraad does disclose summarizing company innovations.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Germeraad and Cho are concerned with the problem of managing information. It would have been obvious to one with ordinary skill in the art at the time of the current invention to combine the teachings of Cho to the invention of Germeraad. The combination of the disclosures taken as a whole, suggests that users would have benefited from the quick and timely retrieval of information over the Internet (See Cho Column 3 lines 36-40). Hence Cho does provide a motivation to combine the two references.

Applicant's other arguments with respect to pending claims 1 and 3-8 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period


Art Unit: 3624

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (571) 272-6747. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PMR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dr. N. Subramanian NSJ
March 16, 2006


HANI M. KAZIMI
PRIMARY EXAMINER